

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS BRAVET and MARC MAURER

MAILED

SEP 30 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-2041
Application No. 09/147,813

ON BRIEF

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand the above identified application once more to the examiner because it is not yet in condition for resolution of all the issues advanced by the appellants and by the examiner on this appeal.

This appeal involves whether the reference evidence adduced by the examiner establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a). However, at this point it would be premature to assess this obviousness issue because the scope of the claim language may be indeterminate.

A rejection under 35 U.S.C. § 103(a) should not be based on speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. If no reasonably definite meaning can be given to certain terms in the claim, the subject matter does not become obvious - the claim becomes indefinite. See In re Wilson, 424 F.2d 1382, 1384, 165 USPQ 494, 496 (CCPA 1970); In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); and Manual of Patent Examining Procedure (MPEP) § 2173.06 (8th Ed., Aug. 2001).

For the reasons which follow the record does not contain adequate development of the meaning of the claims such that a decision can be made on the § 103(a) issue.

BACKGROUND

This appeal is from the examiner's refusal to allow claims 40-65, which are all of the claims pending in this application.

Appellants' invention relates to a glass-free, plastic-containing motor vehicle window and a process for preparing such a window. An understanding of the invention can be derived from a reading of exemplary claim 40, which is reproduced below.

40. A glass-free motor vehicle window, which is at least partly transparent, and which meets French standard R43 for motor vehicle windows, which comprises:

- a.) a plastic layer having a thickness to 5 to 10mm,
 - b.) at least one skin layer of a plastic film having a thickness of 10 to 100 μm coated on said plastic layer, and
 - c.) a scratch-resistant layer having a thickness of 1 to 10 μm supported by said plastic film, wherein said window is prepared by the following process (A) or process (B), wherein process (A) comprises:
 - 1.) providing said skin layer b.), either flat or in shaped form,
 - 2.) subjecting said skin to heat treatment, the skin layer, being supported completely or partly by a mould surface, an auxiliary means for shaping at least part of the skin to the said mould surface being optionally provided so as to relax stresses in the skin, and crosslinking constituent elements thereof; and
 - 3.) joining the skin layer to said plastic layer a.) by hot pressing in a form, or by thermoplastic injecting moulding or reactive injection moulding of the material of the plastic layer a.), the skin having been positioned in the bottom of the mould in such a way that a scratch-resistant layer c.) is in direct contact with the mould;
- and process (B) comprises:
- 1.) depositing the constituent elements of a scratch-resistant layer on a substantially flat plastic film; and
 - 2.) Shaping said film bearing the elements of the scratch-resistant layer into a shape which is the same as or at least similar to the ultimate shape of the end-product, while at the same time at least partly crosslinking the scratch-resistant layer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Motter et al. (Motter)	4,112,171	Sep. 05, 1978
Tatebayashi et al. (Tatebayashi)	4,386,042	May 31, 1983

Oliver et al. (Oliver)	4,634,637	Jan. 06, 1987
Hirmer et al. (Hirmer)	5,525,401	Jun. 11, 1996
Bier et al. (Bier)	5,849,414	Dec. 15, 1998
Arpac et al. (EP '417) (published European Patent Application)	0 524 417	Jan. 27, 1993
Bier (EP '348) (published European Patent Application)	0 718 348	Jun. 26, 1996

Claims 40 through 45, 49, 52 and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motter in view of Hirmer. Claims 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and Bier. Claims 48, 50 and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motter in view of Hirmer and Oliver. Claims 53 through 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and Tatebayashi. Claims 44 and 63 through 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and EP '417 and EP '348.

We refer to the brief and reply briefs and to the answers for an exposition of the opposing viewpoints expressed by appellants and the examiner.

DISCUSSION

All of the appealed claims require a product or a process of making a product that is required to meet "French standard R43 for motor vehicle windows" (independent claims 40, 53 and 56). That standard is also referenced at page 3, lines 28 and 29 of the specification.

In presenting a brief traversing the examiner's prior art rejections, appellants maintain, inter alia, that the "French standard R43 for motor vehicle windows" is a claim limitation that is not taught by the applied prior art. See, e.g., page 10, lines 2-6 of the brief.

In our earlier remand (dated January 24, 2004), we noted, inter alia, that a copy of that R43 standard (in the English language) was not located in the application file. In response, the examiner submitted a supplemental examiner's answer and pointed us to a purported English language copy of the "French standard R43 for motor vehicle windows" that was now present in the application file albeit not fastened thereto.¹ Appellants do not comment on the above-noted copy of the standard referred to

¹ That R43 Paper is now fastened to the right flap of the application file.

by the examiner in the supplemental reply brief filed May 03, 2004.

Our review of that referred to copy of the R43 standard reveals no official office date stamp markings or Paper number marking thereon.² Moreover, the copy of the R43 standard includes a summary (second page) that is dated after the filing date of this application and identifying that document as being a confidential working document for internal use only and as being of no legal value. Moreover, the Annex 14 standard appended thereto includes strike out line markings at several pages thereof suggesting that portions thereof may have been redacted and are not applicable.

Given the above, the record is incomplete as to the meaning of the claimed French standard R43 as of the filing date of this application. Also, it is not clear whether the R43 standard as it existed as of the filing date of this application was widely available to the public and whether any publically available documents describing that standard would fulfill the requirements

² We note that at page 8 of an amendment filed by appellants on October 15, 2001, appellants stated that a copy of the French standard R43 was submitted therewith albeit it is not clear if the copy currently in the application file reflects that referred to document.

for essential material that may be incorporated by reference in support of the claimed subject matter.

Thus, a material issue of claim interpretation and support for the claimed subject matter is present which must be resolved before the merits of this appeal can be fully and properly considered.

This is so because we should not have to speculate or make assumptions as to what is intended by the claims in order to compare the claimed subject matter with the relevant prior art.

Consequently, we remand this application to the examiner to either (1) complete the record relative to the claimed R43 French standard with appellants' assistance or (2) consider introducing new grounds of rejection under the first and second paragraphs of 35 U.S.C. § 112.

It is well established that "definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art."

In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). 35 U.S.C. § 112, second paragraph, requires that: (1) the claim set forth what "the applicant regards as his invention" and (2)

the claim be sufficiently "definite." See Allen Eng'g Corp. v. Bartell Indus. Inc., 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1775 (Fed. Cir. 2002) (quoting Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000) (quoting 35 U.S.C. § 112, second paragraph)). When the present claims are viewed in light of this authority, it does not appear that one skilled in the art would be capable of determining their metes and bounds even when read in light of the specification, on the current record.

If the examiner determines that the additional development of the application file record which is necessitated by the above discussed circumstances cannot be attained, as a practical matter, via the limited framework of supplements to the examiner's answer and the appellants' brief, the examiner should consider reopening prosecution at least for the purpose of pursuing any § 112, first and second paragraph rejections in responding to this remand.

On return of this application, the examiner should take appropriate action to correct the deficiencies identified above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly,

Additionally, this application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed., Rev. 2, May 2004). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

THOMAS A. WALTZ
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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